

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of

Shahana RAHMAN et al.

On Appeal from Group: 2625

Application No.: 10/830,111

Examiner: S. BRINICH

Filed: April 23, 2004

Docket No.: 118445

For: SYSTEMS AND METHODS FOR FORMING COMPOSITE IMAGES WITH DIGITAL
GRAPHIC ELEMENTS

APPEAL BRIEF TRANSMITTAL

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Attached hereto is our Brief on Appeal in the above-identified application.

The Commissioner is hereby authorized to charge Deposit Account No. 24-0037 in the amount of \$540.00, in payment of the fee due under 37 C.F.R. 41.20(b)(2). In the event of any underpayment or overpayment, please debit or credit our Deposit Account No. 24-0037 as needed in order to effect proper filing of this Brief.

Respectfully submitted,


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BRIEF ON APPEAL

Appeal from Group 2625

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I. REAL PARTY IN INTEREST

The real party in interest for this appeal and the present application is Xerox Corporation, by way of an Assignment recorded in the U.S. Patent and Trademark Office at Reel 015262, Frame 0599.

II. RELATED APPEALS AND INTERFERENCES

There are no prior or pending appeals, interferences or judicial proceedings, known to Appellant, Appellant's representative, or the Assignee, that may be related to, or that will directly affect or be directly affected by or have a bearing upon, the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-6, 8, 15, 19, 20 and 22-26 are on appeal.

Claims 1-6, 8, 15, 19, 20 and 22-26 are pending.

Claims 1-6, 8, 15, 19, 20 and 22-26 are rejected.

Claims 7, 9-14, 16-18, 21, 27 and 28 are canceled.

IV. STATUS OF AMENDMENTS

No Amendment After Final Rejection has been filed. The claims stand as amended by Appellants' May 21, 2008 Amendment.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Claim 1 is directed to an image forming device (paragraph [0020], Fig. 1, element 100), comprising: an imaging source (paragraph [0024], Fig. 2, element 300) that scans an input document to obtain input image data (paragraph [0024]); a digital graphic element forming unit (paragraph [0023], Fig. 2, element 200) that processes user-supplied digital graphic element data (paragraph [0026]); a composite image forming device (paragraph [0033], Fig. 2, element 140) that forms a composite image based on the obtained input image data and the user-supplied digital graphic element data (paragraph [0027]), and an output unit (paragraph [0034], Fig. 2, element 400) that prints the composite image on an image receiving substrate.

Claim 20 is directed to a method for forming a composite image in an image forming device (paragraph [0035], Fig. 3), comprising: scanning an input document to obtain an input image in the image forming device (paragraph [0036], Fig. 3, step S1100); retrieving at least one user-supplied digital graphic element stored in the image forming device (paragraph [0042], Fig. 3, step S1400); and forming a composite image on an image substrate output by the image forming device by combining the obtained input image and the retrieved at least one user-supplied digital graphic element (paragraphs [0045]-[0049], Fig. 3, steps S1400-S2000).

The remaining claims are dependent on the above allowable independent claims.

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The following grounds of rejection are presented for review:

1) Claims 1-6, 8, 15, 19, 20 and 22-26 are rejected under 35 U.S.C. §103(a) as being unpatentable over Micrografx Picture Publisher Limited Edition Reference Guide (hereinafter "Micrografx") in view of U.S. Patent No. 5,146,275 to Tone et al. (hereinafter "Tone").

VII. ARGUMENT

The Office Action rejects the pending claims as having been obvious in view of the applied references. However, with respect to at least independent claims 1 and 20, the law relating to obviousness, is improperly applied. Proper application of the law, and reasonable interpretation of the references, demonstrates that the relevant standard for obviousness has not been met, and the claimed subject matter is allowable over the applied references.

A. No Predictability Has Been Shown To Making The Asserted Combination Of References

1. Claim 1

Micrografx and Tone would not have been predictably combined in the manner the Office Action suggests because the combination would impermissibly modify the principle of operation of the Micrografx device and overly complicate the Tone device.

Claim 1 recites an image forming device, comprising: an imaging source that scans an input document to obtain input image data; a digital graphic element forming unit that processes user-supplied digital graphic element data; a composite image forming device that forms a composite image based on the obtained input image data and the user-supplied digital graphic element data, and an output unit that prints the composite image on an image receiving substrate.

With reference to pages 7-40 to 7-44, the Office Action asserts that Micrografx can reasonably be considered to teach many of the features positively recited in independent claim 1. The Office Action concedes, however, that Micrografx does not describe a scanner that scans an input document to obtain input image data or an image forming device that forms and stores a composite image based on the obtained image data and the user-supplied digital graphic element data. Rather, the Office Action relies on Tone as teaching such a feature.

Micrografx is directed to a PC publishing software program in which a user may edit images via a user interface. By contrast, Tone is directed to a composite image forming apparatus including an analog or a digital image forming apparatus of the type in which an optical system moves relative to a document placed on a document table. The image on the document is scanned by the optical system. The image is transferred to a sheet of image transferring paper in a belt like recording medium on which additional or optional images from which additional or optional images other than the document image can be transferred to the sheet of image transferring paper (Abstract).

The Office Action concludes that it would have been obvious to one of ordinary skill in the art to combine Micrografx with Tone because they are from the field of processing scanned images and printing a processed image result. The Office Action further concludes that the references would have been combined in order to apply the control arrangements and interface of Micrografx to the Tone scanner and printer device. This combination is asserted as enabling the Tone device to carry out the full range of image processing described by Micrografx. The analysis of the Office Action fails for at least the following reasons.

There is nothing to suggest that Micrografx lacks any element by which the full range of image processing described in Micrografx may not be able to be carried out. Further, there is nothing in Micrografx or Tone to suggest that one of ordinary skill may have, in any way, predictably combined Micrografx with Tone in the manner suggested by the Office Action, and such has not been otherwise adequately shown.

Micrografx functions on a user PC from which work product may be sent to a printer. Tone teaches a device that scans a document and transfers the image to a sheet of image transferring paper upon which optional images other than the document image can be transferred.

Tone teaches, at least in Fig. 3, that an additional mark is selected via a mark selecting means (col. 10, lines 17-22) for selecting one or two or more optional marks in the mark scanning area 4b (Fig. 1(b)) of a plurality of marks described in the recording medium and is provided with a singularity mark changer switch 11 and a plurality mark changer switch 12. Therefore, because the marks are selected in Tone via a selecting means, they are selected from a predetermined database of marks. In this regard, because Tone already transferred predetermined marks to the transfer paper, the Office Action fails to show that one of ordinary skill in the art would predictably modify the design of Tone to include the Micrografx Picture Publisher.

Accordingly, no predictability has been shown in the Office Action to making the asserted combination of references.

2. Claim 20

Micrografx and Tone would not have been predictably combined in the manner the Office Action suggests because the combination would impermissibly modify the principle of operation of the MicroGrafx device and overly complicate the Tone device.

Claim 20 recites a method for forming a composite image in an image forming device, comprising: scanning an input document to obtain an input image in the image forming device; retrieving at least one user-supplied digital graphic element stored in the image forming device; and forming a composite image on an image substrate output by the image forming device by combining the obtained input image and the retrieved at least one user-supplied digital graphic element.

The Office Action asserts that Micrografx can reasonably be considered to teach many of the features positively recited in independent claim 20. The Office Action concedes, however, that Micrografx does not describe a scanner that scans an input document to obtain input image data or an image forming device that forms and stores a composite image based

on the obtained image data and the user-supplied digital graphic element data. Rather, the Office Action relies on Tone as teaching such a feature.

The Office Action concludes that it would have been obvious to one of ordinary skill in the art to combine Micrografx with Tone because they are from the field of processing scanned images and printing a processed image result. The Office Action further concludes that the references would have been combined in order to apply the control arrangements and interface of Micrografx to the Tone scanner and printer device. This combination is asserted as enabling the Tone device to carry out the full range of image processings described by Micrografx. The analysis of the Office Action fails for at least the following reasons.

There is nothing to suggest that Micrografx lacks any element by which the full range of image processing described in Micrografx may not be able to be carried out. Further, there is nothing in Micrografx or Tone to suggest that one of ordinary skill may have, in any way, predictably combined Micrografx with Tone in the manner suggested by the Office Action, and such has not been otherwise adequately shown.

Micrografx functions on a user PC from which work product may be sent to a printer. Tone teaches a device that scans a document and transfers the image to a sheet of image transferring paper upon which optional images other than the document image can be transferred.

Tone teaches, at least in Fig. 3, that an additional mark is selected via a mark selecting means (col. 10, lines 17-22) for selecting one or two or more optional marks in the mark scanning area 4b (Fig. 1(b)) of a plurality of marks described in the recording medium and is provided with a singularity mark changer switch 11 and a plurality mark changer switch 12. Therefore, because the marks are selected in Tone via a selecting means, they are selected from a predetermined database of marks. In this regard, because Tone already transferred predetermined marks to the transfer paper, the Office Action fails to show that one of

ordinary skill in the art would predictably modify the design of Tone to include the Micrografx Picture Publisher.

Accordingly, no predictability has been shown in the Office Action to making the asserted combination of references.

B. No Objective Evidence Of Record Has Been Provided To Support Making The Asserted Combination

The Office Action summarily concludes that it would have been obvious to combine Micrografx with Tone to enable the Tone device to carry out the full range of image processings described by Micrografx. The Office Action fails to provide any objective evidence of record to support this mere conclusory statement regarding making the asserted combination of references.

The Office Action indicates that Tone teaches an image forming device including a scanner for scanning an input document to obtain input image data and a photo copier image forming device that forms and stores a final output image. However, no objective evidence of record has been provided in the Office Action to support the conclusion that it would have been obvious to combine a composite image forming apparatus with the image processing interface taught in Micrografx to carry out the full range of image processings described by Micrografx in the Tone device. As such, this is merely a conclusory statement.

Further, to any extent that Tone teaches an image forming device including a scanner for scanning an input document to obtain input image data and a photo copier image forming device that forms and stores a final output image, this is not a reasonable conclusion upon which to base the assertion that one of ordinary skill in the art would have predictably combined any of the teachings of the references as suggested by the Office Action with any reasonable expectation of success in achieving the objectives that are achieved by, and in the manner of, the subject matter of the pending claims.

Even after the Supreme Court's decision in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 127 S. Ct. 1727 (2007), the analysis supporting an obviousness rejection must be explicit. The Supreme Court in *KSR* approved the conclusion set forth in a decision of the Federal Circuit in *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006), that "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." This standard is also not met here with the mere conclusory statement that one of ordinary skill in the art may have combined the control arrangements and interface of Micrografx with the Tone device "to enable the Tone device to carry out the full range of image processings described by Micrografx." In other words, to the extent that the conclusory statement provides anything that can be considered an appropriately articulated reasoning, there is certainly no rational underpinning to that articulated reasoning.

**C. The Conclusions Made In The Office Action May
Only Be Reached Through The Impermissible
Application of Hindsight Reasoning**

The Office Action summarily concludes that it would have been obvious to combine Micrografx with Tone to enable the Tone device to carry out the full range of image processings described by Micrografx. This conclusion may only be reached through the impermissible application of hindsight reasoning based on the roadmap provided by Applicants' disclosure.

MPEP §2142 instructs that the proper standard by which to determine obviousness requires (1) that the Examiner step backward in time into the shoes of the hypothetical "person of ordinary skill in the art," (2) that "[i]n view of the factual information, the Examiner must then make a determination of whether the claimed invention 'as a whole' would have been obvious at the time to that person," and (3) that any knowledge gained from Applicants' disclosure must be put aside at reaching this determination in order to avoid the

tendency to resort to the impermissible application of hindsight reasoning based on the roadmap provided by Applicants' disclosure.

The Office Action fails to establish why one of ordinary skill in the art at the time of Applicants' invention may have, in any way, particularly combined Tone with Micrografx in the manner suggested. There is nothing in Tone and/or Micrografx to suggest that one would have predictably combined Micrografx with Tone, and such has not been adequately shown. As such, the only reasonable conclusion that can be arrived at regarding the applied combination is that it is based on the teachings of Applicants' disclosure. Court precedent tells us that it is clearly improper to use the Applicants' teachings against him or her. *See, e.g., In re Sponnoble*, 405 F.2d 578, 585, 160 USPQ 237, 243 (CCPA 1969) (noting that in making its determination a court must view the prior art without reading into that art the patent's teachings).

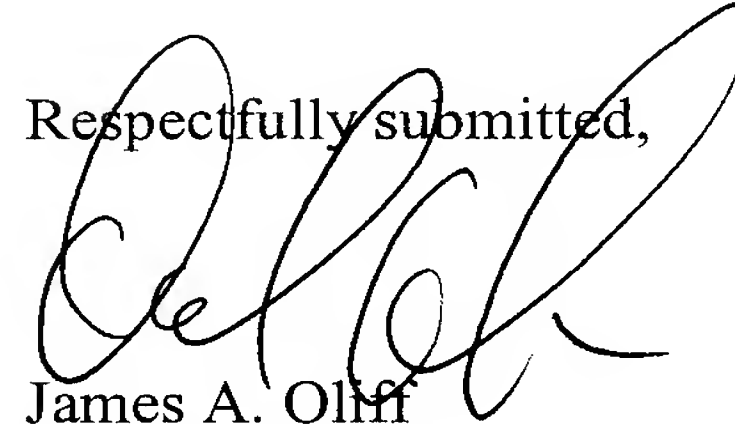
**D. The Dependent Claims Would Not Have Been Rendered Obvious By The
 Applied References For The Additional Features They Recite**

Dependent claims 2-6, 8, 15, 19 and 22-26 would also not have been rendered obvious by the applied references. These claims are allowable for at least the respective dependence of these claims on allowable base claims, but also for the separately patentable subject matter that each of these claims recites.

VIII. CONCLUSION

For all of the reasons discussed above, it is respectfully submitted that the rejections are in error as to claims 1 and 20, and therefore also to each of the claims depending therefrom. Claims 1-6, 8, 15, 19, 20 and 22-26 are in condition for allowance. For all the above reasons, Appellants' respectfully request that this Honorable Board reverse the rejections of claims 1-6, 8, 15, 19, 20 and 22-26.

Respectfully submitted,



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APPENDIX A - CLAIMS APPENDIX

CLAIMS INVOLVED IN THE APPEAL:

1. An image forming device, comprising:
 - an imaging source that scans an input document to obtain input image data;
 - a digital graphic element forming unit that processes user-supplied digital graphic element data;
 - a composite image forming device that forms a composite image based on the obtained input image data and the user-supplied digital graphic element data, and
 - an output unit that prints the composite image on an image receiving substrate.
2. The device of claim 1, the digital graphic element forming unit being configured to read user-supplied digital graphic element data including at least one of a standard or individually user-customized digital graphic element from at least one digital data storage medium and to store the read user-supplied digital graphic element data in the digital graphic element forming unit of the image forming device.
3. The device of claim 2, the digital graphic element forming unit further comprising:
 - a digital graphic element input interface that is usable to input image data associated with the at least one of the standard or individually user-customized digital graphic element from the at least one digital data storage medium;
 - a digital graphic element selecting device that allows the user to select in the image forming device the at least one of the standard or individually user-customized digital graphic element stored in the digital graphic element forming unit in the image forming device;
 - a digital graphic element attribute adjusting device in the image forming device that allows the user to adjust attributes of the selected digital graphic element; and

a digital graphic element positioning device that allows the user to position the selected digital graphic element in the composite image.

4. The device of claim 3, further comprising a user interface in the image forming device configured to allow the user to select the at least one of the standard or individually user-customized digital graphic element from among a plurality of standard or individually user-customized digital graphic elements stored in the digital graphic element forming unit in the image forming device.

5. The device of claim 3, further comprising a user interface in the image forming device configured to allow the user to adjust one or more attributes of the at least one digital graphic element.

6. The device of claim 5, wherein the one or more attributes include at least one of color, contrast, clarity, and intensity of the at least one digital graphic element with respect to one or more like attributes of the obtained input image.

7. (Canceled)

8. The device of claim 3, further comprising a separate digital graphic element user interface by which the user controls the digital graphic element forming unit apart from an input interface by which the user controls the image forming device.

9-14. (Canceled)

15. The device of claim 1, wherein the image forming device is a photocopying device.

16-18. (Canceled)

19. The device of claim 1, wherein the image forming device is a xerographic image forming device.

20. A method for forming a composite image in an image forming device, comprising:

scanning an input document to obtain an input image in the image forming device;

retrieving at least one user-supplied digital graphic element stored in the image forming device; and

forming a composite image on an image substrate output by the image forming device by combining the obtained input image and the retrieved at least one user-supplied digital graphic element.

21. (Canceled)

22. The method of claim 20, further comprising supplying the at least one user-supplied digital graphic element to be stored in the image forming device by reading digital graphic element data from a user-supplied digital data storage medium.

23. The method of claim 22, wherein retrieving the at least one user-supplied digital graphic element further comprises selecting, by a user via a user interface in the image forming device, the at least one user-supplied digital graphic element from among a plurality of user-supplied digital graphic elements stored in the image forming device.

24. The method of claim 20, further comprising adjusting, by a user via a user interface in the image forming device, one or more attributes of the retrieved digital graphic element prior to forming the composite image.

25. The method of claim 24, wherein the one or more attributes adjusted by the user include at least one of color, contrast, clarity, or intensity of the at least one retrieved digital graphic element with respect to one or more like attributes of the obtained input image.

26. The method of claim 20, further comprising determining, by a user via a user interface in the image forming device, a position of the retrieved digital graphic element in the composite image prior to forming the composite image.

APPENDIX B - EVIDENCE APPENDIX

NONE

APPENDIX C - RELATED PROCEEDINGS APPENDIX

NONE